

REMARKS

Claim 74 is added, and therefore claims 42 to 45 and 47 to 72 are pending and being considered (since claims 31 to 41 were previously withdrawn in response to a restriction requirement).

Applicants respectfully request reconsideration of the present application in view of this response.

With respect to page two (2) of the Office Action, claims 42 to 45 and 47 to 71 were rejected under the first paragraph of 35 U.S.C. Section 112 as to the written description requirement.

It is first noted that the Office bears the initial burden of presenting “evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims.” (See M.P.E.P. § 2163.04 (citing In re Wertheim 541 F.2d 257, 262, 265, 191 U.S.P.Q. 90, 96, 98 (C.C.P.A. 1976))) (emphasis added).

The Manual of Patent Examining Procedure also provides that if the Office rejects a claim based on the lack of a written description, the examiner should “identify the claim limitation not described” and also provide “reasons why persons skilled in the art would not recognize the description of this limitation in the disclosure of the application.” (See id.). In this regard, the Office Action does not explain why a person skilled in the art would not recognize the exclusionary feature of claim 42 since, for example, the specification (see pages 3 to 5) specifically discusses the reflected power problem, makes plain that it solves this problem by, for example, frequency variation, so that there is no reference to solving the problem by using the prior reference approach of measuring the ratio of magnitudes of applied and reflected power of the generator (which the office action asserts would have been known by those skilled in the art).

As further regards the written description requirement, as explained above, it is respectfully submitted that the Office Action has not satisfied the Office's *initial* burden of presenting “evidence or reasons why persons skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims.” (See M.P.E.P. § 2163.04 (citing In re Wertheim 541 F.2d 257, 262, 265, 191 U.S.P.Q. 90, 96, 98 (C.C.P.A. 1976))) (emphasis added).

Indeed, the Manual of Patent Examining Procedure itself provides that if the Office rejects a claim based on the lack of a written description, the examiner should “identify the claim limitation not described” and provide “reasons why persons skilled in the art would not recognize the description of this limitation in the disclosure of the application.” (See id.). It is respectfully submitted that the Office Action's arguments and assertions simply do not

identify why the rejected claims are not supported by the written description of the present application (and its specification) — which it plainly is, as explained herein.

As stated by the Board in Ex parte Harvey, 3 U.S.P.Q. 2d 1626, 1627 (Bd. Pat. App. Int. 1986) (emphasis added, citations omitted):

Compliance with the written description requirement of Section 112 only requires that appellant's application contain sufficient disclosure, *expressly or inherently*, to make it clear to persons skilled in the art that appellant possessed the subject matter claimed. The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession of the claimed subject matter, *rather than the presence or absence of literal support in the specification for the claimed language*.

Likewise, as stated by the Board in Ex parte Sorenson, 3 U.S.P.Q. 2d 1462, 1463 (Bd. Pat. App. Int. 1987) (emphasis added):

[W]e are mindful that appellant's specification need not describe the claimed invention in *ipsis verbis* to comply with the written description requirement. *The test is whether the originally filed specification disclosure reasonably conveys to a person having ordinary skill that applicant had possession of the subject matter later claimed.* . . . Moreover, the Examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in appellant's specification disclosure a description of the invention defined by the claims.

In particular, the Sorenson Board, noting that the examiner only essentially stated that the claim expressions at issue did not “appear in the original disclosure” and that the claim expressions were therefore “not adequately supported by the few specific compounds in the specification”, found that the examiner had not met his initial burden of “presenting evidence why a person having ordinary skill in the art would not recognize in appellant's specification a description of the invention defined by the claims” — and that the “only reasoning presented” that the Board could discern was an “example of *ipse dixit* reasoning, resting on a bare assertion by the Examiner”.

In view of all of the foregoing, it is respectfully submitted that the Office Action's arguments and assertions do not satisfy the evidentiary and judicial standards discussed above, and it is respectfully submitted that the Office Action does not establish a prima facie written description case with respect to the present application. It is therefore respectfully

submitted that the present application does satisfy the written description requirement of 35 U.S.C. § 112. Accordingly, it is respectfully submitted that the "written description" rejection of the claims should be reversed.

It is therefore respectfully submitted that the Office Action's arguments and assertions simply do not explain why the subject matter of the rejected claims is not supported by the written description of the present application — which it plainly is for the reasons explained herein.

Accordingly, claim 42 is allowable, as are its dependent claims 43 to 45 and 47 to 71.

New independent claim 74 does not add any new matter and is supported by the present application (including, for example, the specification at pages 3 to 5), and includes the feature which provides that the variation of the frequency is such as to avoid high reflected powers back into the ICP coil generator when the plasma power is pulsed. This feature, as provided for in the context of claim 74, is in no way identically described or even suggested by any of the references applied to date. Accordingly, claim 74 is allowable over the references applied to date, since they do not in any way disclose or suggest this feature.

Accordingly, claims 42 to 45, 47 to 71 and new claim 74 are allowable for all of the above reasons.

CONCLUSION

In view of the foregoing, it is believed that the rejections have been obviated, and that claims 42 to 45, 47 to 71 and 74 are allowable. It is therefore respectfully requested that the rejections be withdrawn, and that the present application issue as early as possible.

Respectfully submitted,
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